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APPLICATION NO. 09/137,859	FILING DATE 08/20/99	FIRST NAMED INVENTOR JOHNSTON	B	ATTORNEY DOCKET NO. PCE200/00117
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HM22/1004

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SCHMID EXAMINER

ARG UNIT

PAPER NUMBER

10/04/99

DATE MAILED:

#16

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/137,059

Applicant(s)

Johnston et al.

Examiner

Schmidt

Group Art Unit

1635

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 30 days ~~MONTH(S)~~ FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-23 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-23 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other CRF Diskette Problem Report

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DETAILED ACTION

1. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth: Note the CRF diskette problem report attached. A new computer readable form and statement that CRF matches the filed sequence listing is required to comply with the sequence requirements.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-17, drawn to nucleic acid molecule compositions, classifiable in class 536, subclass 23.1.
 - II. Claim 18, drawn to method for inhibiting the transcription or translation of a target nucleic acid molecule, classifiable in class 435, subclass 375.
 - III. Claims 19-22, drawn to a method of covalently bonding a platinum molecule to an oligonucleotide and oligonucleotide obtained via said method, classifiable in classes 435 and 536, subclasses 375 and 23.1, respectively.
 - IV. Claim 23, drawn to method for detecting the presence of a target molecule in a composition via binding a catalytically inactive RNA wherein said inactive RNA becomes catalytically active, classifiable in class 435, subclass 6.
3. The inventions are distinct, each from the other because of the following reasons:

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Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method of group II may be practiced with other nucleic acid inhibitors than those of claim 1 or 9 (the compositions of group I) since any antisense, ribozyme or peptide-nucleic acid are known in the art as nucleic acid inhibitors having functions in inhibiting the transcription or translation of a target nucleic acid via binding to a target and thus are topologically linked.

Inventions II and III are distinct because a method for inhibiting the transcription or translation of a nucleic acid via topologically linking a target nucleic acid with another nucleic acid or analog (group II) differs in its scientific considerations from a method of covalently bonding a platinum molecule to an oligonucleotide (group III) since binding a nucleic acid to another nucleic acid (as in group II) involves hydrogen bonding of the two molecules and does not require covalent binding, a platinum donor molecule nor a positively charged polyamine.

Inventions II and IV are distinct because a method for inhibiting the transcription or translation of a nucleic acid via topologically linking a target nucleic acid with another nucleic acid or analog (group II) differs in its scientific consideration from a method for detecting the presence of a target molecule in a composition involving conversion of a catalytically inactive RNA molecule to a catalytically active RNA molecule as in group IV. Group IV specifically

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involves a method for detection of a nucleic acid via a conversion in the catalytic activity of the binding nucleic acid, a function not present in the method of inhibition of group II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent classification and recognized divergent subject matter, and since the search required for each of Group I, II, III and IV is not required for the other Groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

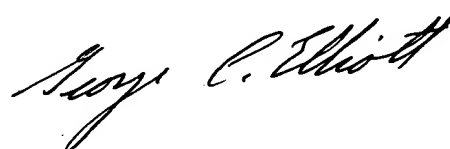
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mary M. Schmidt*, whose telephone number is (703) 308-4471.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *George Elliott, Ph.D.* may be reached at (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

M. M. Schmidt
September 16, 1999



George C. Elliott, Ph.D.
Supervisory Patent Examiner
Technology Center 1600